

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on September 8, 2005. Claims 1-36 are pending in the Application and stand rejected. Claims 3, 4, 18, and 19 are amended by the present Amendment.

Summarizing the outstanding Office Action, the specification and Claims 3-5 and 18-20 were objected to because of several informalities; Claims 1-7, 11, 15-22, 26, 30-36 were rejected under 35 U.S.C. § 102(b) as being anticipated by Takeuchi et al. (U.S. Patent No. 6,408,142, hereinafter "Takeuchi"); Claims 8-10 and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi in view of Miyabe et al. (U.S. Patent No. 6,836,629, hereinafter the '629 patent); and Claims 12-14 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi in view of Miyabe et al. (U.S. Patent No. 5,943,529, hereinafter the '529 patent).

Applicants respectfully bring to the attention of the Examiner that the IDSs filed on this Application on June 1, 2004 and July 16, 2004 have not been properly acknowledged. Specifically, with reference to the IDS filed on June 1, 2004, references CU, CV and CW listed on the Form-1449 have not been acknowledged. If necessary, Applicants are in a position to resubmit copies of those IDSs and the date-stamped filing receipt, documenting that the IDSs was properly filed on the above-noted dates. Applicants respectfully request the Examiner to inform Applicants' representatives at the earliest convenient time about the need to resend copies of the IDS filing documents.

In response to the outstanding objections, Applicants note with appreciation the time taken by the Examiner to identify specific areas needing revisions. Applicants have amended

one paragraph in the specification and the claims, including correction of the cited informalities, and respectfully request reconsideration of the objection thereto. In addition, in view of the present amendment, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

Turning to the anticipation rejection, Applicants respectfully submit that Claim 1-7, 11, 15-22, 26, 30-36 are not anticipated by Takeuchi because each and every element as set forth in those claims is not found, either expressly or inherently described, in the cited reference. In an anticipation rejection, the identical invention must be shown in as complete detail as is contained in the claim.¹

According to a feature of the invention as set forth in the pending independent claims, a process cartridge or an image forming apparatus comprising the same are recited, in which, among other features, *the process cartridge is configured to move in a direction substantially parallel to a longitudinal direction of the image carrier.*

As disclosed in the Specification, one of the objectives of the present invention is the provision of a process cartridge that can be easily inserted and removed from the main body of an image forming apparatus without damaging any of the image forming process devices assembled in the process cartridge and without, at the same time, increasing the cost of the process cartridge. Further, it is desirable to provide an image forming apparatus with enhanced operability to insert and remove such a process cartridge from its main body.² As

¹ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

² Specification, page 2, line 32 – page 3, line 3.

just explained, the novel and advantageous cartridge is configured to move in a direction substantially parallel to a longitudinal direction of the image carrier.

As clearly shown at least in FIGS. 1, 3-7, 15, 19, 28, 29, 30, and 38, of Takeuchi, the process cartridge B does not move in a direction substantially parallel to a longitudinal direction of the image carrier, as recited in Applicants' independent claims, but in a direction substantially *perpendicular* to the longitudinal direction of the photo-sensitive drum 7.

In addition, as to Claims 33-36, Applicants respectfully submit that the outstanding Office Action fails to follow the required procedure to reject a claim containing means-plus-function language by disregarding the structure disclosed in Applicants' specification corresponding to the recited language according to the provisions of 35 U.S.C. § 112, sixth paragraph.³ Furthermore, a *prima facie* case of equivalence has not been made in the outstanding Office Action because the outstanding Office Action is devoid of any explanation and/or rationale as to why the device of Takeuchi is equivalent to the structures disclosed corresponding to the recited functions in Claims 33-36.⁴

In particular, the outstanding Office Action is devoid of an explanation or rationale to explain: (1) how the device of Takeuchi performs an identical function substantially the same way to produce substantially the same results as the structures of the present invention;⁵ (2) how one of ordinary skill in the art recognizes the interchangeability of the elements of

³ "The broadest reasonable interpretation that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." MPEP § 2181, citing *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

⁴ MPEP § 2183 requires that an Examiner "provide an explanation and rationale in the Office Action as to why the prior art element is an equivalent."

⁵ A showing that "the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

Takeuchi to the ones disclosed in Applicants' specification;⁶ (3) how the differences between elements in Takeuchi and corresponding elements disclosed in Applicants' specification are insubstantial;⁷ or (4) how elements in Takeuchi are structural equivalents of the corresponding elements disclosed in Applicants' specification.⁸

Applicants respectfully submit that since the cartridge of Takeuchi is configured to be inserted and removed perpendicularly to the longitudinal direction of the photo-sensitive drum 7, it does not perform the identical function substantially the same way to produce substantially the same results as the disclosed structures of the cartridge and image forming apparatus of the present invention. Moreover, given the substantial difference in their function and the final result produced, one of ordinary skill in the art would not recognize the interchangeability of elements in the device of Takeuchi with the elements disclosed in Applicants' specification and would not have found the differences between elements in Takeuchi and corresponding elements disclosed in Applicants' specification insubstantial because of their structural differences as summarized hereinabove.

⁶ A showing that "a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus. Inc.*, 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998); *Lockheed Aircraft Corp. v. United States*, 193 USPQ 449, 461 (Ct. Cl. 1977); and *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196, 1 USPQ2d 2052 (Fed. Cir. 1987).

⁷ A showing that "there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138 (Fed. Cir. 2000); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040, 41 USPQ2d 1865, 1875 (1997); *Valmont Industries, Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 25 USPQ2d 1451 (Fed. Cir. 1993); and *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000).

⁸ A showing that "the prior art element is a structural equivalent of the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Given the above-summarized differences in structures, operations, and purposes of the invention of Takeuchi and Applicants' invention, Applicants respectfully submit that the Office has not carried its burden as required for the proper rejection of Claims 33-36.

As such, Applicants respectfully submit that Claims 1, 16, 33, and 35 are not anticipated by Takeuchi. Claims 2-7, 11, 15, 17-22, 26, 30-34, and 36 should be allowed, among other reasons, as depending either directly or indirectly from Claims 1, 16, 33, or 35, which should be allowed as just explained. In addition, Claims 2-7, 11, 15, 17-22, 26, 30-34, and 36 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied reference when those features are considered within the context of the subject matter recited in independent Claims 1, 16, 33, or 35. Therefore, Applicants respectfully request that the anticipation of Claims 1-7, 11, 15-22, 26, 30-36 under 35 U.S.C. §102(b) be withdrawn.

As to the obviousness rejections based on the primary reference of Takeuchi, Applicants respectfully submit that neither the '529 patent nor the '629 patent can remedy the above-noted failure of Takeuchi. Thus, Takeuchi, the '529 patent, and the '620 patent, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in the claims of this application. This is so because, even when combined, these references do not teach or suggest all the claimed features. In addition, the proposed modification of Takeuchi by the teachings of the '629 patent would make Takeuchi unsatisfactory for its intended use since the Office is proposing to place handles on sides where delicate tracks are provided for the proper insertion and removal of the toner cartridge of Takeuchi.


For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 8-10, 12-14, 23-25, and 27-29 under 35 U.S.C. § 103(a).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-36 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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